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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,815	04/28/2006	Jonas Scherble	285453US0PCT	6973
22850 7590 03/11/2010 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER LENIHAN, JEFFREY S				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
03/11/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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**Advisory Action**  
**Before the Filing of an Appeal Brief**

**Application No.**

10/577,815

**Applicant(s)**

SCHERBLE ET AL.

**Examiner**

Jeffrey Lenihan

**Art Unit**

1796

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 01 March 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because:  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-15.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.  
12. ☐ Note the attached *Information Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

/ Irina S. Zemel/  
Primary Examiner, Art Unit 1796

Continuation of 3. NOTE: The proposed amendment introduces new claims 16-19 without cancelling any finally rejected claims. These claims recite the use of 1-10 parts of t-butyl methacrylate (TBMA); this range was not recited in any previous version of the claims. The proposed amendment therefore narrows the scope of the claimed invention and would require further search and consideration to determine patentability.

Claims 14 and 15 in the proposed amendment are verbatim repetitions of claims 1 and 3, respectively; claims 14 and 15 therefore recite the same invention as claims 1 and 3 contrary to the requirements of 37 C.F.R. 1.75. By extension, dependent claims 18 and 19 recite the same invention as claims 16 and 17.

Claims 17 and 19 recite the process for producing a polymer of claims 3 and 15, respectively; however, claims 3 and 15 recite polymers, not processes. New claims 17 and 19 are therefore both indefinite under 35 U.S.C. 112, 2<sup>nd</sup> paragraph.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments regarding the amount of TBMA and the allegedly unexpected results have already been addressed in the previous Office Action, incorporated herein by reference, with regards to claims 1-15. With regards to the range of 1-10 parts TBMA (claims 16-19); arguments regarding this range are directed towards an invention defined by a combination of limitations not recited in the currently pending claims and are therefore not relevant to the patentability of the claimed invention.

Regarding the rejection of claims under 35 U.S.C. 112, 1<sup>st</sup> paragraph: Applicant cites page 10, lines 22-29 of the specification as providing support for the use of acrylonitrile and acrylic acid. The examiner first notes that acrylonitrile is not recited in the list of possible monomers in the passage cited by applicant. As discussed in the previous Office Action, incorporated herein by reference, the original disclosure teaches the preparation of the claimed composition using methacrylonitrile; acrylonitrile is not disclosed. For acrylic acid, the examiner notes that the original disclosure recites that component (A) of the invention comprises 30-70 parts by weight (pbw) methacrylic acid, 30-60 pbw of methacrylonitrile, and 0-30 pbw of other monomers having vinyl unsaturation (see page 7, lines 10-14; page 8, lines 5-11). The passage cited by applicant as providing support for the use of acrylic acid lists examples of the other monomers having vinyl unsaturation; the original disclosure does not recite the use of 30-70 pbw of acrylic acid instead of methacrylic acid or 30-60 pbw acrylonitrile instead of methacrylonitrile. The rejection of claims under 112, 1<sup>st</sup> paragraph is therefore maintained.